

Application No. 10/677,694  
Docket No. IB-8 (A4-1770)  
Reply dated February 6, 2008  
In response to Office Action of May 9, 2008

## **REMARKS**

As of the filing of the present Office Action, claims 1-14, 17-31, 33-40, 44, 48-58, 60-63, and 65-72 were pending in the above-identified US Patent Application.

Applicants wish to thank Examiner Mallari for not making final the rejections of the claims, as stated in a phone message on June 9, 2008.

In the Office Action, the Examiner objected to Applicants' amendment filed June 6, 2008 under 35 USC §132 as introducing new matter into the disclosure, rejected independent 2, all of its dependent claims, and claim 61 (which depends from claim 1) under 35 USC §112, first paragraph, rejected independent claim 1 and all but claim 61 of its dependent claims under 35 USC §103, and allowed independent claim 31. In response to the above, Applicants have amended the claims as set forth above. More particularly:

Independent claim 1 has been amended to incorporate the limitations of its dependent claim 61. Claims 60, 61 and 63 (which depend from claim 1) have been canceled and claim 62 (which depends from claim 1) has been amended for consistency with the amendment to claim 1.

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Independent claim 2 and its dependent claims have been amended to use the term “reader” instead of “readout device,” consistent with the specification, and claim 2 has been further amended to describe the function of the reader in terms consistent with page 5, line 18, through page 6, line 12, of Applicants’ specification.

Applicants respectfully believe that the above amendments do not present new matter, and request favorable reconsideration of remaining claims 1-14, 17-31, 33-40, 44, 48-58, 62, and 65-72 in view of the following comments.

**New Matter Objection; Rejection under 35 USC 112, first paragraph**

The Examiner objected to Applicants’ amendment filed June 6, 2008, as introducing new matter into the disclosure, and rejected independent 2, its dependent claims, and claim 61 under 35 USC §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that Applicants had possession of their claimed invention at the time their application was filed.

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The object and rejection were both premised on the argument that Applicants' original disclosure did not disclose an embodiment in which there is an external reader and a power unit, as shown in new Figure 7 (presented with the amendment of June 6, 2008).

The first full paragraph on page 11 of Applicants' original specification is reproduced below for the convenience of the Examiner.

The system may be implemented as a closed-loop pacing/ICD (Implantable Cardioverter Defibrillator) tuning system, in which sensor data is fed to a patient pacemaker for tailoring of pacing/ICD function. The implanted sensor 101, 201, may be directly interrogated by the pacing/ICD unit (i.e. without requiring an intermediate reader unit). It may also be interrogated by the pacing/ICD unit, but with an additional, external unit solely for transmitting power to the implant. Alternatively, the sensor data may first be transmitted to an external reader and then re-transmitted to the pacing/ICD unit. Finally, the system may be configured such that both an external reader and the pacing/ICD unit may interrogate and/or power the sensor. (Emphasis added.)

"The system" identified on page 11 refers to the "system" referred to earlier in Applicants' Detailed Description at page 5, line 15, and page 10, line 22. At the first instance of its use in the Detailed Description, the term "system" is

introduced as follows:

. . . the present invention provides a wireless sensing system. The system comprises two parts: an implantable pressure monitor which is securely anchored in a cavity of the heart; and a reader that both transmits power to and receives transmitted data from the implant.

Consequently, “the system” identified on pages 5, 10 and 11 of the specification includes an implantable sensing device and a reader.

The description on page 11 then proceeds to define a further embodiment in which “[t]he implanted sensor 101, 201, may be directly interrogated by the pacing/ICD unit (i.e. without requiring an intermediate reader unit) . . .” Such a description does not preclude the presence of the reader, but merely renders the reader unnecessary for interrogating the sensing unit.

The next sentence in this paragraph states “[the sensing device] may also be interrogated by the pacing/ICD unit, but with an additional, external unit solely for transmitting power to the implant” (emphasis added). Simply because an “additional” external unit can perform the powering function of the reader does not preclude the presence of the reader or its powering and data

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receiving functions. Furthermore, the word “additional” when describing the “external unit” is meaningless if the reader (referred to as an “external reader” in the specification) is not included in the system described on page 11.

In summary, nothing in paragraph 11 expressly states that the reader is not a component of the system, and nothing in paragraph 11 suggests that the reader cannot a component of the system. Therefore, Applicants believe that the embodiments described on paragraph 11 describe a pacing/ICD unit and an external power unit as additional components of Applicants’ claimed system, and therefore Applicants respectfully request withdrawal of the objection under 35 USC §132 and the rejections under 35 USC §112, first paragraph.

### **Rejections under 35 USC 103**

At page 13 of the Office Action, the Examiner stated

No statement of allowability is being given at this time for [independent claim 2, its dependent claims, and claim 61 which depends from claim 1] in light of the rejection under 35 U.S.C. 112, 1<sup>st</sup> paragraph, set forth above. Upon resolution of the 112 issues, the prior art will be revisited.

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Applicants wish to kindly remind the Examiner that

When evaluating claims for obviousness under 35 U.S.C. 103, all the limitations of the claims must be considered and given weight, including limitations which do not find support in the specification as originally filed (i.e., new matter.) (Citation omitted.)

MPEP §2143.03.

Applicants respectfully believe that independent claims 1 and 2 and their remaining dependent claims are allowable over the prior art of record.

**Closing**

Should the Examiner have any questions with respect to any matter now of record, Applicants' representative may be reached at (219) 462-4999.

Respectfully submitted,



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